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YONG SZE FAN & ANOR

v.

SHARIFAH MOHD TAMIN & ORS

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HIGH COURT MALAYA, KUALA LUMPUR
RAMLY ALI J
[ORIGINATING MOTION NO: D6(IP)-25-20-2005]
18 DECEMBER 2007

C ***TRADEMARKS:*** *Registered trade mark - Expungement - Application for - Whether TAMIN a trade mark satisfying registrability requirements set out in s. 10(1)(d) Trade Marks Act 1976 - Whether mark distinctive and capable of distinguishing goods - Whether mark in its ordinary meaning a surname - Whether there was extensive usage of the mark by*
D *the respondents even before application for registration - Whether mark rightfully entered into register - Trade Marks Act 1976, ss. 14, 19, 25, 45, 46*

TRADEMARKS: *Registered trade mark - Expungement - Application*
E *for - Whether there has been prior mark on register - Applicability of s. 19(1) and (3) Trade Marks Act 1976 - Whether applicants misconstrued the law and interpreted section wrongly - Whether respondents as first users should have priority in rights over TAMIN trade mark - Trade Marks Act 1976, ss. 10, 14, 25, 45, 46*

F ***TRADEMARKS:*** *Registered trade mark - Expungement - Application for - Whether there was bona fide intention to use trade mark in relation to goods - Whether usage of mark would give rise to confusion and deception - Whether registered proprietor/registered user of mark should be called to task for offending acts of subsequent user - Whether first user*
G *should prevail - Trade Marks Act 1976, ss. 10, 14, 19, 25, 45, 46*

TRADEMARKS: *Registered trade marks - Passing off - Whether respondents first users of TAMIN - Whether applicants' use of mark amounted to passing off - Whether respondents' rights prejudiced by*
H *subsequent user - Issue of damages - Whether arose - Whether applicants' case under s. 14 Trade Marks Act 1976 bound to collapse - Trade Marks Act 1976, ss. 10, 19, 25, 45, 46*

TRADEMARKS: *Registered trade marks - Expungement - Application*
I *for - Whether entry rightfully made and remaining on register - Whether respondents bona fide proprietors of mark - Whether respondent legitimately recorded as registered proprietor - Whether registration of mark contrary to law - Trade Marks Act 1976, ss. 10, 19, 25, 45, 46*

The applicants prayed for, *inter alia,* the following orders (i) a declaration that the word TAMIN as a trade mark in the name of Sharifah Mohd Tamin for mineral and aerated waters and non-alcoholic beverages and syrups and other preparations for making beverages; all included in Class 32 would result in confusion and deception to the public and would be contrary to law; (ii) a declaration that trade mark registration number 98/13089 was an entry wrongfully made into the register and the entry was defective; (iii) in the alternative, a declaration that trade mark registration number 98/13089 was an entry wrongfully remaining on the register without sufficient cause and (iv) an order that trade mark registration number 98/13089 be expunged from the register of trade marks in relation to the goods of interest. This action was premised on the applicants' claim that they were the first users of TAMIN in relation to syrups and cordials when their products bearing TAMIN was introduced into the market in 1990. There were also extensive sales and promotion of the applicants' products bearing the TAMIN trade mark since its introduction. According to the applicants, it had on 15 September 1990 applied for registration of the trade mark TAMIN in respect of goods included in Class 32 in Malaysia and the first respondent had only registered the trade mark on 11 November 1998. The respondents, however, claimed that the first respondent was the rightful proprietor of the trade mark under registration number 98/13089 and the said trade mark was an entry rightfully entered/remaining on the register maintained under the Trade Marks Act 1976. According to the first respondent, TAMIN was first used as a trade mark by her late father, Hj Tamin Wahi from 1951. Initially the TAMIN trade mark was used in relation to (soya source) kicap. Since its humble beginning in just selling kicap, the business of Hj Tamin expanded and started selling a variety of food and drink items. The expansion of the business also necessitated the formations of companies which were the third and fourth respondents. The respondents took steps to register their trade mark which made up of the word TAMIN in relation to various items of food and drink. According to the respondents, despite the registration of the TAMIN trade mark in relation to mineral and aerated waters and non-alcoholic beverages (which is the specification of goods under trade mark 98/10389) in 1998, the mark has been used by Syarikat Salmi Hj Tamin and Syarikat Zamani Hj Tamin since the 1980s. The respondents contended that the Tamin group and their predecessors in title were the first users of the TAMIN mark even in relation to syrups and items of

drink. It was also important to observe that the High Court at Kuala Lumpur under the D5 suit had made a finding of fact on this very issue where the court held that the applicants (who were defendants in the said case) were not the first users of the TAMIN mark even in relation to syrups and cordials.

In the application to remove and expunge the first respondent's trade mark TAMIN from the register of trade marks, the applicants had relied on s. 45(1) of the Trade Marks Act 1976 read together with ss. 14, 19, 25 and also s. 46 of the same Act. The applicants had set out reasons as to why the trade mark under registration number 98/13089 should be expunged which were (i) the word TAMIN is not the name of an individual, company or firm represented in a special or particular manner; (ii) the trade mark offended s. 19 of the Trade Marks Act 1976; (iii) the trade mark offended s. 25 of the Trade Marks Act 1976; (iv) that the registration of the subject mark was in respect of 'one class' or of a large variety of goods or services where the first respondent had no intention to use the mark in relation to these goods in the class and (v) the trade mark offended the provisions of s. 14 of the Trade Marks Act 1976.

Held:

(1) TAMIN is a trade mark which would satisfy the registrability requirements set out in s. 10(1)(d) of the Trade Marks Act 1976 and could function as a trade mark. The mark was distinctive within the meaning of the Trade Marks Act 1976 in that it was capable of distinguishing the goods of the respondents from the goods of other traders. The mark was both inherently and factually distinctive of the respondents. Since TAMIN is not the normal or usual way of describing the goods of interest, other traders without improper motive need not use the mark to describe similar goods. The mark in its ordinary meaning is not a surname. This was acknowledged by the applicants themselves when they sought to register TAMIN as a trade mark. It would be preposterous if the respondents' mark was not allowed to proceed to registration and the applicants' mark was allowed. The respondents have various other TAMIN registrations which showed that the mark was registrable. TAMIN is further distinctive of the respondents due to their extensive usage of the mark even

before the application for registration of the mark. The mark had been rightfully entered into the register. (paras 25, 26, 28, 31 & 36)

(2) For the applicants to succeed, they firstly need to show that there has been a prior mark on the registrar. The only marks which have been identified by the applicants were trade marks under application numbers 90/6139 and 92/00224. Both these trade marks are pending and have not matured to registration. By virtue of this, they are not trade marks entered upon the register and thus should not be considered in the determination of s. 19(1) of the Trade Marks Act. With regard to the applicability of s. 19(1) of the Trade Marks Act the applicants have misconstrued the law and have interpreted the said section wrongly. Further, even if s. 19(3) of the Trade Marks Act had application to the facts of this case, the fact that the respondents were the first users would clearly mean that it was them and not the applicants who should have priority in rights over the TAMIN trade mark in Malaysia. (paras 39, 40 & 42)

(3) There was ample evidence in the various affidavits filed including affidavits filed by the applicants that the respondents and their predecessors in title were the first users of the trade mark TAMIN in relation to the goods covered by the registration. If the applicants' submissions was accepted, it would create a situation where a subsequent user could defeat an earlier user on the premise that they had filed the application for registration earlier. This surely could not be the right principle in law. The position that the first user should prevail was also well founded by the court in *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor.* (paras 46 & 47)

(4) It has been a policy employed by the Trade Mark Registry to ensure that the applicant for registration of a trade mark does not claim for goods that they may not have an interest in. This does not necessarily imply that class headings as specifications are not registrable. So long as the goods covered under the registration are in use or if there is a *bona fide* intention to use the said trade mark in relation to the goods that could be said to be class headings, the registration should not be denied. As a matter of fact the trade mark registry itself, which is responsible for the policy had seen it

fit to accept the respondents' mark for registration. It was not a sufficient ground to justify the expungement of the subject mark. The applicants have not led any evidence to show or to suggest that there had been no intention to use the mark by the respondents in relation to those goods. (paras 51 & 52)

(5) There was no question that the applicants' trade mark TAMIN was identical or so closely resembling trade mark under registration number 98/13089. However this did not necessarily imply that use of trade mark under registration number 98/13089 by the first respondents or the registered users would give rise to confusion and deception. Clearly if the respondents and their predecessors in title were the first parties to use the mark, a subsequent user could not come along and claim that the said registered trade mark would cause confusion and deception by reason of the presence of their subsequent mark. In such a scenario, it was not use of the registered mark by the registered user or registered proprietor that caused confusion and deception but rather the subsequent use of the mark by the applicants that caused such an effect. Surely the registered proprietor or registered user of the mark should not be called to task for the offending acts of a subsequent user. (paras 59 & 61)

(6) It had been decided that the third and fourth respondents and their predecessors in title were the first users of TAMIN in relation to a wide range of food and drink products. The court had also held that the applicants' use of TAMIN amounted to passing off. Given that the respondents and their predecessors in title within the TAMIN group of companies were the first in time to use the TAMIN trade mark, surely their rights should not be prejudiced by a subsequent user. The applicants' claim that the registration would result in confusion and deception by reason of their use of TAMIN would have to collapse. The issue of damages also clearly did not arise on the facts given the fact that the respondents were well within their rights to use the said trade mark. The applicants' case under s. 14 of the Trade Marks Act 1976 was thus also bound to collapse. (paras 66, 69, 72 & 77)

(7) The trade mark under registration number 98/13089 was an entry rightfully made and rightfully remaining on the register maintained under the Trade Marks Act 1976. None of the prayers sought should be granted. Being the first in time, the respondents were *bona fide* proprietors of the mark in relation to the goods specified under trade mark 98/13089. The first respondent could be legitimately recorded as the registered proprietor by virtue of the internal arrangement between her and the other respondents within the TAMIN group of companies. Registration of the respondents' mark could not be said to be contrary to law. There were various reasons for the court exercising discretion in favour of maintaining trade mark under registration number 98/13089. (paras 85 & 86)

Case(s) referred to:

Eastman Photographic Materials Company Ld for a Trade Mark [1898] RPC 476 ***(refd)***

Erven Warnink v. Townend & Sons [1979] 2 All ER 927 ***(refd)***

Luk Lamellen Und Kupplungsbau GmBh v. South East Asia Clutch Industries Sdn Bhd [1996] 3 CLJ 904 HC ***(dist)***

Mark Foy's Ltd v. Davis Coop & Co Ltd [1956] 95 CLR 190 ***(refd)***

Phantom Trade Mark [1978] RPC 245 ***(refd)***

Reckitt & Colman Products Ltd v. Borden Inc & Ors [1990] 1 All ER 873 ***(refd)***

Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor [2006] 5 MLJ 262 ***(refd)***

W & Gdu Cros Application [1913] 30 RPC 660 ***(refd)***

Legislation referred to:

Trade Marks Act 1976, ss. 3, 10(1)(a), (d), (e), 14(1)(a), 19(1)(b), (a)(2), (3), 25(1), 28, 45(1), 46, 48(5)

Trade Marks Regulations 1997, reg. 18(3)

Other source(s) referred to:

Kerly's Law of Trade Marks, 11th edn, pp 103, 104

Manual of Trade Marks Law and Practice In Malaysia, 2nd edn, para 9.20

For the applicants - Bahari Yeow; M/s Lee Hishamuddin Allen & Gledhill
For the respondents - S Indran; M/s Shearn Delamore & Co

Reported by Suhainah Wahiduddin

JUDGMENT

Ramly Ali J:

The Application

[1] The notice of originating motion (encl. 1) filed by the applicants pray for the following orders:

i. A declaration that the word TAMIN as a trade mark in the name of Sharifah bt Mohd Tamin for mineral and aerated waters and non alcoholic beverages; fruit beverages and fruit juices, syrups and other preparations for making beverages; all included in class 32 would result in confusion and deception to the public and would be contrary to law;

ii. A declaration that trade mark Registration Number 98/13089 is an entry wrongfully made into the register and the entry is defective;

iii. In the alternative, a declaration that trade mark Registration Number 98/13089 is an entry wrongfully remaining on the register without sufficient cause;

iv. An order that trade mark Registration Number 98/13089 be expunged from the register of trade marks in relation to the goods of interest;

v. Costs; and

vi. Such other relief as the court deems fit and just.

[2] The 3rd, 4th and 5th respondents have been added in as respondents following an application by them to intervene in the proceedings which the court has allowed. The reason why the application was made and granted was that the 3rd, 4th and 5th respondents were registered users of trade mark under Registration Number 98/13089 which is the subject matter of this dispute. As registered users, any decision granted by the court would have an impact on their rights.

The Applicants' Case

[3] This action was premised on the applicants' claim that they were the proprietors of the TAMIN mark in relation to syrups and cordials. The applicants' based their assertions on the followings:

i. That they were the first users of TAMIN in relation to syrups and cordials when their products bearing TAMIN were introduced into the market in 1990.

ii. At the time of their introduction of TAMIN in relation to those goods, no other party had been using TAMIN in the course of trade in relation to those goods.

iii. There was extensive sales and promotion of the applicants products bearing the TAMIN trade mark since it's introduction. However these sales and promotional efforts as admitted by the applicants was confined to the Kelantan market.

iv. Various evidence of use was submitted to support the applicants' contention.

[4] The applicants then went on to suggest that by reason of their priority of rights, the registration of the Trade Mark 98/13089 in the name of Sharifah bt Mohd Tamin was an entry wrongfully entered into the register.

[5] From their affidavits in support of the application, the applicants claimed as follows:

(a) The applicants started manufacturing cordials, flavourings and syrups under a trade mark consisting of the word "TAMIN" since 1990 and the device of a sickle has also been used together with the word "TAMIN" as the applicants' trade mark for cordials, flavourings and syrups since 1991.

(b) The word 'TAMIN" was not used as a trade mark for cordials, flavourings and syrups by any other party when the applicants first used their "TAMIN" trade mark.

(c) The applicants have used their "TAMIN" trade mark continuously and extensively since 1990 for cordials, flavourings and syrups. The applicants annual turnover of cordials, flavourings and syrups bearing the applicants' "TAMIN" trade mark exceed RM1 million.

(d) The cordials, flavourings and syrups manufactured by the applicants bearing the applicants' "TAMIN" trade mark are now being sold in 90% of the sundry shop in the state of Kelantan.

(e) The applicants have continuously and extensively advertised its cordials, flavourings and syrups bearing the applicants' "TAMIN" trade mark in various media since 1990.

(f) The applicants' "TAMIN" mark is also the subject of trade mark applications for registrations since as early as 1990.

(g) The applicants had on 15 September 1990 applied for registration of the Trade Mark No: 90-06139 "TAMIN" in respect of syrups, cordial fruit juice, flavour concentrate, soft drinks and other non-alcoholic drinks, all included in Class 32 in Malaysia.

(h) The 1st respondent had on 11 November 1998 applied for registration of the Trade Mark No: 98-01389 "TAMIN" in respect of mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, all included in Class 32 in Malaysia. The 1st respondent's mark was subsequently registered.

(i) As at this date, there was prior use or application by the applicants for the same mark in the same class of products.

The Respondents' Case

[6] The respondents' case is set out in the three affidavits of Sharifah bt Mohd. Tamin. The respondents claimed that the 1st respondent is the rightful proprietor of the trade mark under Registration Number 98/13089 and the said trade mark was an entry rightfully entered/remaining on the register maintained under the Trade Marks Act 1976.

[7] The affidavits of Sharifah bt Mohd Tamin (1st respondent) which supports the respondents' case show the following facts:

(a) TAMIN was first used as a trade mark by Sharifah's late father Hj Tamin bin Wahi from 1951. Initially the TAMIN trade mark was used in relation to (soya source) kicap.

(b) With the passage of time the business run by Hj. Tamin expanded and two businesses were set up under the names Syarikat Salmi Hj. Tamin and Syarikat Zamani Hj Tamin. These businesses were the predecessors in title of the 3rd and 4th respondents. The two businesses were set up as Hj. Tamin had two surviving wives and there was a business for each of his wives.

(c) Since its humble beginning in selling just 'kicap', the businesses of Hj Tamin expanded and started selling a variety of food and drink items. The expansion of the business also necessitated the formations of companies which were the 3rd and 4th respondents. The increase in the range of products produced and sold by the 3rd and 4th respondents and their predecessors in title can be seen from the exh. ST2 which is a joint brochure by the companies within the Tamin group of companies which included the 3rd, 4th and 5th respondents. As can be observed, these extensions covered products such as tauchu, bihun, kerisik, cencaluk, sup tulang, vinegar, chili and tomato sauces and drinks.

(d) There has been extensive sales and promotion of the "TAMIN" products particularly by the 3rd and 4th respondents and/or their predecessors as evidenced by the sales figures, random invoices, the audited accounts, promotional expenditure and advertising materials. The sales invoices further demonstrate and show the wide range of products for which the "TAMIN" trade mark is used in relation to.

(e) The respondents took steps to register their trade mark which made up of the word "TAMIN" in relation to various items of food and drink. This is shown in exh. ST9. It was decided within the group that the trade mark registration would be in the name of the 1st respondent, Sharifah bt Mohd Tamin and the 3rd, 4th and 5th respondents would be recorded as registered users. This is an internal arrangement and does not concern the applicants in this case.

(f) Similarly the trade mark which is the subject matter of this dispute (98/13089) was filed in the name of the 1st respondent (ST10 is the registration certificate for the said mark) and the 3rd, 4th and 5th respondents were entered as registered users. (ST11 confirms these parties as registered users).

(g) Despite the registration of the "TAMIN" trade mark in relation to mineral and aerated waters and non alcoholic beverages; fruit beverages and fruit juices, syrups and other preparations for making beverages (which is the specification of goods under Trade Mark 98/13089) in 1998, the mark has been used by the Syarikat Salmi Hj. Tamin and Syarikat

Zamani Hj Tamin since the 1980s. A photo of the product is found in exh. ST12. Evidence of sales of the "TAMIN" in relation to those specific goods are set out in exh. ST13.

(h) The respondents contended that, the Tamin group and their predecessors in title were the first users of the "TAMIN" mark even in relation to syrups and items of drink. It is important to observe that the High Court at Kuala Lumpur under Suit No D5-22-4760-98 (the D-5 Suit) has made a finding of fact on this very issue where the court held that the applicants (who were defendants in the case) were not the first users of the "TAMIN" mark even in relation to syrups and cordials. The respondents and/or their predecessors in title were the first users of the "TAMIN" even in relation to syrups and cordials.

Applicable Law

[8] In the application to remove and expunge the 1st respondent's trade mark "TAMIN" from the Register of Trade Marks, the applicants rely on s. 45(1) of the Trade Marks Act 1976 read together with, ss. 14, 19, 25; and also s. 46 of the same Act.

[9] Section 45(1) of the Act provides as follows:

> Subject to the provisions of this Act:
>
> (a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as if thinks fit;
>
> (b) the Court may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the Register …

[10] The grounds for rectification of the 1st respondent's trade mark is based on, amongst others, the entry of the subject mark in the register is made wrongfully or without sufficient cause, *viz*

(a) the 1st respondent is not the lawful proprietor of the subject mark and the 1st respondent has made a wrongful claim to be proprietor; and

(b) the use of which is likely to deceive or cause confusion to the public as the subject mark conflicts with a pending application at the time of registration.

[11] Both these ss. 45 and 46 of the Act provide for the expungement of a trade mark from the register. Section 45 gives the power to the court to cancel or vary an entry which was wrongfully entered or wrongfully remaining on the register. Section 46 on the other hand deals with expungment of an entry which has not been used for a period of three years up to one month preceding the application to cancel.

[12] It is however important to observe that although s. 46 has been mentioned in the entitlement, the evidence and facts raised do not support such an allegation. No evidence of non-use of the trade mark has been raised covering the material time, to show that the mark should be expunged on the grounds of s. 46. On the contrary, the respondents have presented use of the mark in relation to the goods of interest as set out in the affidavits of the 1st respondent. The court assumes that the applicants are not pursuing this line of attack to the validity of trade mark under Registration Number 98/13089.

[13] The court has wide powers and discretion in this regard to expunge or vary a trade mark on the register maintained under the Trade Marks Act. However in the exercise of these powers, the court must be satisfied that the entry is wrongfully made/remaining on the register. For this, guidance is sought from the provisions of the Trade Marks Act.

[14] Under s. 45, the applicants first have to prove that they have the necessary *locus standi* as an aggrieved party. Essentially the applicants would have to prove that they would be adversely affected by the continued presence of Trade Mark 98/13089 on the register. Unfortunately for the applicants, sufficient evidence has not been led or pled to show how they are aggrieved parties. This in itself is fatal to the application. Notwithstanding that, the court shall move on to consider the other substantive grounds raised by the applicants in the application and the affidavits.

[15] *Vis a vis* the substantive grounds, the applicants have set out five broad reasons as to why trade mark under Registration Number 98/13089 should be expunged. They are as follows:

A i. The word "TAMIN" is not the name of an individual, company or firm represented in a special or particular manner;

ii. The trade mark offends s. 19 or the Trade Marks Act 1976.

iii. The trade mark offends s. 25 of the Trade Marks Act 1976.

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iv. The specification of goods is a class heading.

v. The trade mark offends the provisions of s. 14 of the Trade Marks Act 1976.

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Findings Of Court

[16] The court shall now consider the reasons raised by the applications one by one.

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The Word TAMIN Is Not The Name Of An Individual, Company Or Firm Represented In A Special Or Particular Manner

[17] This objection finds its roots in s. 10(1) of the Trade Marks Act 1976 which provides as follows:

E

> (1) In order for a trade mark to be registrable ..., it shall consist of at least one be the following particulars:
>
> (a) the name of an individual, company or firm represented in a special or particular manner;
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> F
>
> (b) the signature of the applicant for registration or some predecessor in his business;
>
> (c) an invented word or words;
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> G
>
> (d) a word having no direct reference to the character and quality of the goods [or services] not being according to its ordinary meaning, a geographical name or surname; or
>
> (e) any [other] distinctive mark.

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[18] From the wordings of s. 10(1) it is clear that only one condition needs to be satisfied for the mark to be considered to be registrable. There is no necessity for the proprietor of the mark to fulfill every single condition as that was not the intention of

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s. 10(1). It therefore follows that a trade mark which does not satisfy 10(1)(a) does not necessarily imply that the trade mark is not registrable. A trade mark may still be registrable if it fulfills any one of the above conditions under s. 10(1).

[19] This position was accepted *In the Matter of Application of the Eastman Photographic Materials Company Ld for a Trade Mark* [1898] RPC 476 where Lord Herschell in the House of Lords held at p. 484 that "the words that introduce the section, the particulars designated under the headings (a) to (e) are treated as separate and distinct". The House of Lords here were interpreting a provision of the then UK Act, which dealt with registrability of trade marks. The provision was similar to that found under the Malaysian Trade Marks Act 1976 and starts of with the phrase "Mark must consist at least one of the particulars …" and thus would be equally relevant and applicable for the purposes of interpretation of our s. 10(1). This would be coupled with the obvious literal and purposive interpretation of s. 10(1).

[20] The applicants in this case are not suggesting that Trade Mark 98/13089 does not fulfil all the grounds set out in s. 10(1) which is what would be required to successfully argue that the trade mark was entered without sufficient cause under s. 10. Therefore their arguments on this ground would be bound to fail.

[21] In any case the court is of the view that the mark at the very least satisfies the requirements set out in s. 10(1)(d) and 10(1)(e).

[22] The court shall first consider s. 10(1)(d). For marks to have direct reference, it must be the normal or usual way of making the reference. In *Mark Foy's Ltd v. Davis Coop & Co Ltd* [1956] 95 CLR 190 it was held that "the test must lie in the probability of ordinary persons understanding the words, in their application to the goods, as describing or indicating or calling to mind their nature or some attribute they possess."

[23] The mark clearly does not make direct reference to the character and quality of the goods claimed under Trade Mark 98/13089. No sensible person would use "TAMIN" to refer to the character of drinks in general. It is after all a source identifier. In fact the applicants have themselves admitted to this by filing their own "TAMIN" trade marks for registration. How can the applicants claim that the mark is not registrable when they themselves have applied for registration of the very same mark.

[24] Case law has further suggested that so long as the registration does not deprive legitimate trade, it would be allowed. The issue as to whether the mark can be accepted is dependent on whether other traders would desire to use the mark to describe

their products. With the exception of the applicants, no party has used "TAMIN" in relation to drinks. The use by the applicants, on the other hand, has been objected to by the 3rd and 4th respondents as unauthorised and which led to the D5 Suit, which was decided in favour of the 3rd and 4th respondents.

[25] What is more relevant is the admissions in Yong's 1st affidavit, that the applicants' use of the "TAMIN" trade mark was as a source identifier and not as a descriptor. On this admission, it is clear that "TAMIN" is a trade mark which would satisfy the registrability requirements set out in s. 10(1)(d) and could function as a trade mark. This in itself allows the mark to be registered under s. 10(1).

[26] The court is of the view that the mark is distinctive within the meaning of the Trade Marks Act 1976 in that it is capable of distinguishing the goods of the respondents from the goods of other traders. The mark is both inherently and factually distinctive of the respondents in this case.

[27] In deciding inherent distinctiveness, the case of *W & Gdu Cros Application* [1913] 30 RPC 660 can be relied upon. It was held by Lord Parker at p. 671 as follows:

> The Applicant for registration in effect says 'I intend to use this mark as a trade mark ie, for the purpose of distinguishing my goods from the goods of other persons', and the Registrar or the Court has to determine, before the mark is admitted to registration, whether it is such a kind that the applicant, quite apart from the effects of registration, is likely to attain the object he has in view. The applicant's chance of success in this respect, must, I think largely depend upon whether other traders are likely, in the ordinary course of their business and without improper motive, to desire to use the same mark, or some mark closely resembling it, upon or in connection with their own goods.

[28] Flowing from this argument, it is clear that since "TAMIN" is not the normal or usual way of describing the goods of interest, other traders without improper motive need not use the mark to describe similar goods. Emphasis is added to the word improper motive as the use by the applicants in this case cannot count as their use is not as a descriptor but to gain some unlawful advantage to the detriment of the respondents.

[29] The evidence has also shown extensive usage of "TAMIN" by the respondents and their predecessors in title. This means that the trade mark is factually distinctive as well as being inherently distinctive. A

[30] It is also pertinent to observe that the first respondent has various other registrations of marks which incorporate the word "TAMIN." This is set out in exh. ST9 of Sharifah's 1st affidavit. This is clearly indicative of the registrability of the mark. The applicants have further not demonstrated as to why Trade Mark 98/12089 (which is the subject matter of this motion) should be treated any differently. B C

[31] For this reason, the court is satisfied that the registration of Trade Mark 98/13089 satisfies the requirements of s. 10(1) of the Trade Marks Act and that the mark has been rightfully entered into the register. D

[32] The applicants are suggesting that the respondents trade marks cannot be registered as it falls foul of ss. 10(1)(d) and 10(1)(e) and yet maintain that their application for the very same mark should proceed to registration. This is a preposterous and wholly unreasonable position to take. The applicants cannot blow hot and cold at the same time. E

[33] In any case, the approach taken by the applicants can be easily dismissed on the following premise. Firstly even if we were to consider the contention relied upon by the applicants, it is clear that this prohibition would only apply if the mark according to its ordinary meaning is a surname. Further the surname must be common and taken as such. This is surely not the case on our set of facts and neither has it been shown on the evidence by the applicants. The mark is a distinctive source identifier in that it identifies the goods of the respondents due to their long and consistent use of the "TAMIN" trade mark. F G

[34] Going back to the general principles of distinctiveness, it is important to stress that registration would be allowed so long as there is no prejudice to legitimate trade. Flowing from this argument, it is clear that since "TAMIN" is not the normal or usual way of describing the goods of interest, other traders without improper motive need not use the mark to describe similar goods. H I

[35] This court can draw judicial notice from the fact that there are various surnames which have either been recognised as very good trade marks or registered as such. This would include McDonald's, Honda, Mercedes Benz etc. Referring to *Kerly's Law of Trade Marks* (11th edn) at pp. 103 and 104, various surnames have been registered. This clearly shows that prohibition of a surname from trade mark registration is not a hard and fast rule and would only be prohibited in the event that it is either a common surname and it is according to its ordinary meaning a surname which is not distinctive of the respondents. The facts of each case must be examined. Unfortunately for the applicants, it has not been shown on the facts or stated in the pleadings in the present case.

[36] In summary, in this case, the registration has been rightly granted for the following reasons:

(i) The mark in its ordinary meaning is not a surname. This is in a way acknowledged by the applicants themselves when they sought to register "TAMIN" as a trade mark. It would be preposterous if the respondents mark is not allowed to proceed to registration and the applicants mark is allowed.

(ii) The respondents have various other "TAMIN" registrations, which goes to show that the mark is registrable. "TAMIN" is further distinctive of the respondents due to their extensive usage of the mark even before the application for registration of the mark.

(iii) There are various other surnames such as Mc Donald's, Honda, Mercedes Benz which have either been registered as trade marks or recognised as trade marks. If this court were to hold a blanket prohibition on all so called surnames, it would result in a fundamental shift in trade mark law and protection.

The Trade Mark Offends s. 19 Of The Trade Marks Act 1976

[37] In this regard, the applicants are relying on s. 19(1) of the Trade Marks Act which states as follows:

(1) No trade mark shall be registered in respect of any goods or description of goods:

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to such goods; or

(b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

[38] There are two limbs to this restriction. Firstly the mark that is challenged must not be identical or nearly resembling another mark on the register. Secondly both marks must be in relation to the same goods or description of goods.

[39] The court finds that the facts clearly show that the applicants have failed to establish the above. For the applicants to succeed, they firstly need to show that there has been a prior mark on the register. The only marks which have been identified by the applicants are trade marks under application numbers 90/6139 and 92/00224 as set out in exh. YSF10. Both these trade marks are pending and have not matured to registration. By virtue of this, they are not trade marks entered upon the Register and thus should not be considered in the determination of s. 19(1). The court would refer to the definition section of the Trade Marks Act to consider what is a registered trade mark. Section 3 of the Trade Marks Act 1976 provides that a "registered trade mark means a trade mark which is actually upon the register." A pending mark which has not matured to registration is not considered a mark that is appearing on the Register. (See further *Kerly's Law of Trade Marks and Trade Name* Vol. 11 and *Trade Mark Law and Practice in Malaysia*).

[40] With regard to the applicability of s. 19(1), it is clear that the applicants have misconstrued the law and have interpreted the s. 19(1) wrongly. When the word "or" is used, the provisions should be read disjunctively. However if s. 19(1)(b) is looked at, the words make reference to "such a trade mark". Unfortunately for the applicants, "such a trade mark" has to be looked with reference to the trade mark entered upon the register referred to in para. 19(1)(a). There is no other possible interpretation as otherwise which trade mark are the applicants referring to? Therefore it is clear that the s. 19(1) would only bite in the event that the mark relied upon is a registered mark.

[41] The applicants then went on to rely on s. 19(3) of the Trade Marks Act 1976. The court is of the view that this issue does not deserve much mention, as it is clear that the applicants have misconstrued the applicability of these provisions. Firstly unlike s. 19(1) and 19(2) where there is a prohibition to registration, s. 19(3) is a provision, which place the discretion of allowing the mark to proceed to registration upon the Register of Trade Marks Malaysia. In the present case the registrar has so exercised this discretion in favour of the respondents in registering the mark. If the applicants have an issue with this, they could have taken action against the Registrar of Trade Marks Malaysia for a wrongful exercise of this discretion. This was not done if the pleadings are considered. It is trite law that parties to an action are to canvass their case within the four corners of their pleadings. To extent the scope of the case during the submissions stage is both unfair and against this well entrenched principle.

[42] However even if s. 19(3) has application to the facts of this case, the fact that the respondents are the first users would clearly mean that it is they and not the applicants who should have priority in rights over the "TAMIN" trade mark in Malaysia.

The Trade Mark Offends s. 25 of the Trade Marks Act 1976

[43] Section 25(1) of the Act provides:

> (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for registration of that mark in the Register in the prescribed manner.

[44] The basis of the applicants contentions here would be that respondents cannot claim to be *bona fide* proprietor of the mark since they (the applicants) were the first users of the mark in relation to syrups and cordials or items of drinks.

[45] First there is the applicants' contention that when the subject trade mark was applied for in 1998 by the first respondent, the applicants had already been using the trade mark in issue in relation to the goods of interest. Therefore by reference to s. 25 of the Trade Marks Act 1976, the applicants state that the first respondent cannot claim to be the *bona fide* proprietor of the mark. Reference was sought to the Annotated Statutes of Malaysia and Trade Mark Law and Practice in Malaysia, both of which have been reproduced in the applicants bundle of authorities. Then the applicants sought to drive home this point

by relying on the decision of *Luk Lamellen Und Kupplungsbau GmBh v. South East Asia Clutch Industries Sdn Bhd* [1996] 3 CLJ 904. It is important to observe that the facts in *Luk Lamellen* are distinctly different from that in this case. In *Luk Lamellen* the applicants in that case were the first user of the mark in dispute in Malaysia. The same cannot be said of this case where it is the respondents and their predecessors in title who are the first users. And if p. 908 of the decision of *Luk Lamellen* is considered, the position canvassed by the applicants in that case which was not disputed by the respondents and which was accepted by the court was that the "first user of a trade mark in a country becomes the lawful proprietor of the mark in that country."

[46] In the present case, there is ample evidence in the various affidavits filed including the affidavits filed by the applicants that the respondents and their predecessors in title were the first users of the trade mark "TAMIN" in relation to the goods covered by the registration. In fact, this was an issue which was considered at depth by this court in the case of *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor* [2006] 5 MLJ 262. If the applicants submissions on this point is accepted, it would create a situation which is precisely what *Luk Lamellen* wanted to avoid where a subsequent user can defeat an earlier user on the premise that they had filed the application for registration earlier. This surely cannot be the right principle in law.

[47] In fact the position that the first user should prevail was also well found by this court in *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v Yong Sze Fun & Anor* [2006] 5 MLJ 262 at p. 298 where it is stated that "It is trite law that the first to use the mark in Malaysia would prevail. Otherwise it would result in an anomaly in the law in the sense that the first and original user is defeated by a subsequent user". Whilst that case dealt with a claim in passing-off by the 3rd and 4th respondents (as plaintiff's) against the applicants (as defendants), the principle would have to be considered with applicability in this case.

The Specification Of Goods Is A Class Heading

[48] On this issue the applicants claimed that the registration of the subject mark is in respect of "one class" or of a large variety of goods or services where the 1st respondent has no intention to use the mark in relation to these goods in the class. The subject mark is in respect of class 32 – "for mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages."

[49] The applicants relied on reg. 18(3) of the Trade Marks Regulations 1997, which provides:

> In the case of an application for registration in respect of all the goods or services included in one class, or of a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or which he intends to make if and when it is registered.

[50] The applicants further relied on the *Manual of Trade Marks Law and Practice In Malaysia*, 2nd edn, para 9.20 which provides as follows:

> Regulation 18(3) provides that where an application is made for all the goods or services in a class (whether or not comprising the whole of a class), the Registrar may refuse to accept the application unless the claim is justified. This provision stems from the requirement that a proprietor must, at the time of his application, either be using the mark or have a fixed intention to do so, and is in line with the intention of section 46(1) which enables the Court to expunge the registration if it was obtained by an applicant without any *bona fide* intention to use the mark "in relation to those goods or services", i.e. the goods or services for which it is registered.

[51] It has been a policy employed by the Trade Mark Registry to ensure that the applicant for registration of a trade mark does not claim for goods that they may not have an interest in. This does not necessarily imply that class headings as specifications are not registrable. So long as the goods covered under the registration are in use or if there is a *bona fide* intention to use the said trade mark in relation to the goods that could be said to be class headings, the registration should not be denied. As a matter of fact the Trade Mark Registry itself, which is responsible for the policy has seen it fit to accept the respondents' mark for registration.

[52] In any case if the International Classification of Goods and Services are examined, the goods claimed under Trade Mark 98/13089 do not correspond exactly with the class heading of Class 32. The class headings for Class 32 is highlighted in the Third Schedule to the Trade Mark Regulation. This ground relied upon by the applicants to remove Trade Mark 98/13089 is so frivolous that it does not deserve further consideration. Is is not a sufficient ground to justify the expungement of the subject mark.

The applicants have not led any evidence to show or to suggest that there has been no intention to use the mark by the respondents in relation to those goods.

The Trade Mark Offends s. 14 Of The Trade Marks Act 1976

[53] The applicants are saying that the use of the subject mark by the respondents is likely to deceive or cause confusion to the public, thus offending s. 14(1) of the Trade Marks Act 1976.

[54] Section 14(1)(a) provides:

> 14. Prohibition on registration.
>
> (1) A mark or part of a mark shall not be registered as a trade mark:
>
> (a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law.

[55] The affidavit of the 1st applicant suggest that this would appear to be the principle ground relied upon by the applicants in their quest to expunge the trade mark under Registration Number 98/13089. The applicants have premised their contention on the footing that it is they and not the respondents or the Tamin group of companies who were the first parties to use the "TAMIN" trade mark *vis a vis* the goods set out in the specification of goods found under Trade Mark Registration No. 98/13089. They have relied on evidence of use of "TAMIN" by them in relation to syrup bases and cordials since 1990 and alleged that at that time "TAMIN" had not been used in relation to those specific goods by any party (including the respondents). This as the evidence would show is not an accurate reflection of the facts as "TAMIN" in relation to those specific goods have been in use by the respondent and their predecessors in title from the 1980s. This is set out in the 1st respondent's, 1st affidavit as well as exhs. YSF18 and YSF19 in the 1st applicant's.

[56] Section 14 sets out various grounds which if satisfied prohibit the registration of a trade mark. For the purposes of this application though, the evidence as led only points towards an allegation on the part of the applicants that the mark offends s. 14(1)(a). This too on an evaluation of the facts would clearly show that Trade Mark 98/13089 does not offend the provisions of s. 14(1)(a).

[57] To succeed under this ground, the defendants would have to show that the use of the mark would likely to deceive or cause confusion or if use would be contrary to law.

[58] Taking the issue of confusion and deception first, it would seem that the applicants' case would be on the basis that the use of the mark would cause confusion and deception by reason of the presence of their trade mark "TAMIN" in relation to similar products.

[59] There is no question that the applicants' trade mark "TAMIN" is identical or so closely resembling trade mark under Registration Number 98/13089. This is not a disputed fact. However this does not necessarily imply that use of trade mark under Registration Number 98/13089 by the 1st respondents or the registered users would give rise to confusion and deception. Clearly if the respondents and their predecessors in title were the first parties to use the mark, a subsequent user cannot come along and claim that the said registered trade mark would cause confusion and deception by reason of the presence of their subsequent mark.

[60] In such a scenario, it is not use of the registered mark by the registered user or registered proprietor that causes confusion and deception but rather the subsequent use of the mark by the applicants that causes such an effect. Surely the registered proprietor or registered user of the mark should not be called to task for the offending acts of a subsequent user.

[61] The issue that has to be determined therefore is that which party was the first in time to use the mark "TAMIN". Here the evidence is conflicting. The respondents contention is that they or their predecessors in title have been using "TAMIN" since the 1950s in relation to a variety of food and drink items. With specific reference to syrups and cordials, use commenced in the 1980s. The applicants on the other hand contend that they have been using "TAMIN" in relation to syrups and cordials since 1990. They have further denied the fact that the respondents and their predecessors in title have been using "TAMIN" trade mark in relation to syrups when they first introduced their "TAMIN". Nevertheless they do seem to acknowledge that "TAMIN" has been used in relation to other items such as kicap from early on. Their allegation is that "TAMIN" was used by the respondents only since the mid 1990s in relation to syrups and well after their first use of "TAMIN".

[62] As the evidence would show, it is the respondents' contentions that hold weight over the applicants' stand. This can be seen from the evidence.

[63] The applicants have argued that they have used "TAMIN" mark since 1990. The respondents while not admitting this as the commencement date of the use of "TAMIN" by the applicants have nevertheless went on to state that they had used "TAMIN" in relation to syrups and cordials before the 1990s. In fact, the respondents and/or their predecessors in title had been using "TAMIN" in relation to items of drink since the 1980s.

[64] This is corroborated by the applicants' own evidence as set out in exhs. YSF18 and YSF19 of the 1st applicant's affidavit. As a matter of fact, this part of the evidence was considered in a corresponding suit filed by the 3rd and 4th respondents against the applicants in KL High Court Suit No. D5-22-4760-1998 [2006] 5 MLJ 262 (the D5 Suit). As a brief introduction, the D5 Suit was a passing-off suit filed by the 3rd and 4th respondents against the applicants for passing-off. The 3rd and 4th respondents in their claim alleged that the use by the applicants of the "TAMIN" trade mark in relation to syrups and cordials amounted to passing-off the applicants goods as and for the goods of the 3rd and 4th respondents. The case for the 3rd and 4th respondents was premised on their earlier use of "TAMIN" mark in relation to a variety of food and drink items. The applicants' counterclaimed for passing-off claiming that *vis a vis* syrups and cordials, they were the first users and it was the 3rd and 4th respondents who were indulging in passing-off. The court found in favour of the 3rd and 4th respondents allowing their claim and dismissing the applicants' counterclaim.

[65] Coming back to the analysis of exhs. YSF18 and YSF19 (survey reports by the applicants), the court refers to the decision of this court in the case of *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor (supra)*. This court in carefully analysing the very survey evidence found in YSF18 found that the survey pointed to the direction that the 3rd and 4th respondents has used "TAMIN" in relation to syrups even before the use of "TAMIN" by the applicants. This court in that case had the following to say in the evaluation of exhs. YSF18 as well as YSF19 at p. 298.

A Firstly DW-6 in cross examination admitted that no interviews were conducted pursuant to the survey after 26.3.2000. In page 395 of Bundle B6, pursuant to questions asked during the survey (the findings of which were admitted as D-128), it was clear that 33% of those buying TAMIN syrup had been using it for more
B that 10 years at the time the interview was conducted. Although admittedly 29% of the said respondents identified that Defendants TAMIN syrup as the brand that they had been using for more that 10 years, this finding can hardly be said to be accurate. Firstly at the time of the interview, the Defendants TAMIN syrup had not been used for 10 years. This is an admission by the
C DW-1. We have also seen from the evidence of PW-1 during cross examination that TAMIN had been used in relation to syrups by the Plaintiffs and/or their predecessors since the 80s or perhaps even earlier given the long history of the Plaintiffs and predecessors in title over the TAMIN trade mark. Further with
D reference to exhibit D-130 (which are questionnaires done by the Defendants) with particular reference to pages 528, 529, 581, 591, 593, 594, 638. 640 of Bundle B6, it is clear that some of the respondents had been using syrups and cordials hearing the TAMIN trade mark in the 1980s which is well before its use by the Defendants.

E

Therefore the court is satisfied that the TAMIN syrup that had been used for more than ten years at the time the survey was conducted would have to be the plaintiffs or their predecessors TAMIN syrup. Given the fact that it clearly could not have been the defendants syrup (which by admission was only introduced in
F late 1990), it must have been the plaintiffs or their predecessors TAMIN syrup (as admitted by PW1).

Being the first in time even in Kelantan, which is not necessarily the stronghold of the Plaintiffs, the Plaintiffs would and should have prior rights to the TAMIN trade mark. It is trite law that
G the first to use a mark in Malaysia would prevail. Otherwise it would result in an anomaly in the law in the sense that the first and original user of a mark is defeated by a subsequent user.

[66] This is a finding of fact which points towards the direction
H that "TAMIN" in relation to syrups and cordials were first used by the 3rd and 4th respondents who were the plaintiffs in the D5 Suit before the use of the applicants, who were the defendants in the D5 Suit. This is despite the court's finding deficiencies in the survey in the sense that the survey was not balanced. An
I examination of YSF18 would show the following observations *vis a vis* the survey which is found in p. 284 of the case:

(i) The survey was conducted on background facts provided by the applicants without independent verification.

(ii) The survey did not address all the products of the 3rd and 4th respondents. Only soya sauce and syrups were considered although the 3rd and 4th respondents had a wide array of food and drink items as presented in the evidence.

(iii) The survey was conducted in Kelantan only and could hardly be said to be balanced. Kelantan being the stronghold of the applicants and an area where the 3rd and 4th respondents were not that aggressive.

(iv) Only specific targets were the subject matter of the survey and these target were identified as those who would potentially purchase the applicants' products. No attempts were made to ascertain the potential targets of the 3rd and 4th respondents products.

(v) There were deficiencies in the manner conclusions were reached.

[67] Despite this attempt by the applicants to obtain a one sided report which should have favoured the applicants, the court nevertheless found as above that the survey confirmed that the respondents and their predecessors in title were the first users of the "TAMIN" trade mark in relation even to items of drink. This was the case even in the geographical area of Kelantan where the respondents and/or their predecessors in title were not that active.

[68] This being the case, the respondents should prevail in this case. As stated by this court in *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor (supra)* (at p. 298) that "It is trite law that the first to use the mark in Malaysia would prevail. Otherwise it would result in an anomaly in the law in the sense that the first and original user is defeated by a subsequent user".

[69] These are findings of fact reached in the D5 Suit. It has been decided that the 3rd and 4th respondents and their predecessors in title were the first users of "TAMIN" in relation to a wide range of food and drink products. The applicants has sought to side step this decision by stating that the issues in the D5 Suit was different to the issues in this case. To a certain degree, the applicants are right in the sense that the D5 Suit dealt with a claim in passing-off by the 3rd and 4th respondents against

A the applicant, whereas this present application deals with the validity of a registered trade mark. However it is important to bear in mind that the factual findings arrived at in that case are of great relevance to the facts of this case. Firstly, the court has held that the respondents and their predecessors in title were the first in
B time to use the trade mark "TAMIN" and this is the case even in relation to syrups and drink items. Then the court went on to hold that the applicants' use of "TAMIN" amounted to passing-off. Given that the respondents and their predecessors in title within the Tamin group of companies, were the first in time to use
C the "TAMIN" trade mark, surely their rights should not be prejudiced by a subsequent user. It is trite law that the first in time would prevail.

[70] We have seen from the evidence set out in the 1st
D respondent's first affidavit that the internal arrangement between the parties would be that the 1st respondents would hold the trade mark registrations (including trade mark under Registration Number 98/13089) and that the use of the marks would be by the 3rd, 4th and 5th respondents. The 1st respondent is further
E the executive chairperson in the 3rd, 4th and 5th respondents and the 3rd, 4th and 5th respondents have been recorded as registered users. This is a totally regular arrangement and is recognised by the Trade Marks Act 1976. The registered user provisions set out in s. 48 of the Trade Marks Act 1976 are
F testament to this. Section 48(5) provides that "Where a person has been registered as a registered user of a trade mark, the use of that trade mark by the registered user within the limit of his registration shall be deemed to be use by the registered proprietor of the trade mark to the same extent as the use of the trade mark
G by the registered user and shall be deemed not to be use by any other person."

[71] This being the case, the use of the trade mark by the 3rd, 4th and 5th respondents would be taken as use by the 1st
H respondent. Attacks by the applicants that the 3rd, 4th and 5th respondents are different entities from the 1st respondent thus does not hold weight on the facts and should be dismissed. In any case the registered user arrangements are internal arrangements and the applicants whose goods are unconnected to that of the
I respondents should not question or raise this as an issue.

[72] By virtue of the above and by virtue of the fact that the respondents and/or their predecessors in title were the first users of "TAMIN" mark in relation to a wide range of food and drink items, it has to be concluded that the applicants' claim that the registration would result in confusion and deception by reason of their use of "TAMIN" would have to collapse.

[73] The court shall now move on to consider the second limb of s. 14(1)(a). This provision states that registration would be refused if the use of the mark would be contrary to law. Case law has suggested that this would be invoked if the use of the mark would result in passing-off or copyright infringement. There are no issues of copyright infringement presented in the affidavit of the 1st applicant. It would thus seem that the 1st applicant has premised his claim in passing-off to state that registration of trade mark under Registration Number 98/13089 would be contrary to law.

[74] To show passing-off, the applicants would have to satisfy the requirements set out in the classical House of Lords cases of *Erven Warnink v. Townend & Sons* [1979] 2 All ER 927 and *Reckitt & Colman Products Ltd v. Borden Inc & Ors* [1990] 1 All ER 873. These cases were adopted in the decision of *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v Yong Sze Fun & Anor (supra)* where the criteria was set out as follows:

(i) the claimant would have to show goodwill and reputation.

(ii) the actions of the defendants are likely to and/or have actually caused misrepresentation;

(iii) damages have been suffered as a result.

[75] From the facts of the case, given the fact that the respondents and/or the predecessors in title are the first users of "TAMIN" trade mark in relation to items of drink, it is unlikely that the applicants' can establish that they had the requisite goodwill or reputation as any such alleged goodwill and reputation must be and would be subject to the goodwill or reputation of the respondents.

[76] Clearly the requirement of misrepresentation would not be met as the respondents are well within their rights to use the "TAMIN" trade mark in relation to the goods of interest. Firstly the respondents and/or their predecessors in title have been using the "TAMIN" trade mark in relation to a variety of food and

drink items since 1951. In relation to syrups and cordials, the respondent's use commenced in the 1980s. This is clearly before any alleged use of "TAMIN" mark by the applicants. There is thus no issue of misrepresentation arising out of the usage of "TAMIN" mark by the respondents. Misrepresentation, if any, flow from the acts of the applicants and thus cannot be used as a basis for challenging the registration of trade mark under Registration Number 98/13089. This is the finding of fact arrived in the D5 Suit where the court in allowing the claim of the 3rd and 4th respondents also went on to dismiss the counter-claim of the applicants for passing-off.

[77] The issue of damages clearly do not arise on the facts given the fact that the respondents were well within their rights to use the said trade mark. The applicants' case under s. 14 of the Trade Marks Act 1976 is thus also bound to collapse.

Discretionary Power Of The Court

[78] The court must also stress that the burden of showing that the entry is an entry wrongfully entered/remaining on the register falls on the applicants. This goes on the basic and trite principle, "he who asserts should proof". The applicants clearly have not discharged this burden.

[79] Having said that, it has to be recognised that even assuming the applicants have succeeded in proving any of their grounds sought for, this does not necessarily imply that the court would grant the prayers that they are seeking and grant the expungement. The court always retains discretion as to whether the mark should be expunged and certain factors are considered in the exercise of this discretion. For this we would consider the decided cases on point.

[80] In the *Phantom Trade Mark* [1978] RPC 245, Goff LJ had the following to say at p. 251:

> If I had reached a different conclusion and had come to the view that the entries were initially wrong and ought not to have been made, nevertheless it is clear that the court has a discretion on an application for rectification, and even where the initial entry was contrary to an express prohibition in the statute, the court, once it has been made, may, having regard to all the circumstances, permit it to remain. In the present case I would have thought that reasons advanced by Colt for exercising that discretion in favour of allowing the entry to stand, are such that if it were necessary

we ought so to exercise our discretion. He relied first upon the good faith of Colt; their genuine interest in the mark; that the use of the mark has continued to this day; that the parties have to rely on the practice of the Registrar, which Colt did; that there was no evidence that there was anybody deceived or likely so to be; that it was not in the public interest to rectify the Register; and that Chrysler had now completely lost interest in the whole matter. For these reasons had I reached the conclusion that the entry was bad, for my part I would, in the exercise of discretion allow it to stand". (This decision was accepted in the Malaysian case of *Tiga Gajah Cho Heng Sdn Bhd v Majuperak Tepung Beras Sdn Bhd* [1997] 2 AMR 1777).

[81] Turning to the facts of this case, even assuming the court were to find that "TAMIN" in relation to syrups and cordials were first used by the applicants, there are many reasons as to why trade mark under Registration Number 98/13089 should not be expunged. The reasons are set out briefly as follows:

(i) The "TAMIN" trade mark on the undisputed evidence had been in use by the respondents and their predecessors in title since 1951. The first use was in relation to kicap and subsequently extended to cover a wide range of food and drinks items. There is further evidence to suggest that "TAMIN" was chosen as it represents the name of the father of the 1st respondent and the founder of the respondents' predecessors in title. There was thus a genuine interest to register and use the said trade mark in relation to the goods specified under Registration Number 98/13089.

(ii) Even if we accept that "TAMIN" trade mark in relation to syrups and cordials were first used by the applicants, this does not necessarily mean that the respondents are not entitled to make the application for registration. Food and drinks are items of the same description as found by this court in the case of *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor (supra)*. It can further be observed that there is a culture of expansion of the goods of interest to the respondents and this culture is well known to the trade and public. This finding was also reached in the case of *Syarikat Zamani Hj Tamin Sdn Bhd & Anor v. Yong Sze Fun & Anor (supra)*. This would mean that there is a legitimate reason to seek registration of the mark.

(iii) The evidence has further shown that the respondents have continued to use the trade mark to this day.

(iv) The respondents have further taken steps to protect and enforce their rights to the trade mark "TAMIN" and this is shown by the institution of the D5 Suit and a favourable finding for the respondents.

(v) The respondents use of the "TAMIN" trade mark would not cause confusion and deception in the market. On the contrary as found in the D5 Suit, it is the applicants' use that would cause confusion and deception in the market.

(vi) It is further in the public interest for the trade mark under Registration Number 98/13089 to remain. The respondents and their predecessors in title had been using the "TAMIN" trade mark for a substantial period of time in relation to a variety of food and drink items. The public have come to recognize goods bearing the "TAMIN" trade mark as originating from the respondents. This being the case, to remove the trade mark would be unfair and unjust and would certainly send the wrong message to the trade and public not to mention to frustrate the true intention of the Trade Marks Act 1976. The respondents should be well entitled to the continued usage of the TAMIN trade mark in relation to items set out in the specification of goods of Trade Marks 98/13089.

[82] Having said the above, the evidence has demonstrated that "TAMIN" in relation to even articles or drink, including syrups and cordials were first used by the respondents and their predecessors in title. This would mean that in addition to the court's ability to exercise discretion in favour of the respondents, the court can make this finding based on the prior rights of the respondents to "TAMIN" *vis a vis* even items of drink.

[83] In addition to the above, the affidavits filed by the applicants suggest attempts on their part to mislead the court on the following issues:

(i) An assertion that their trade mark under application number 90/06139 had been accepted (para 24 of Yong's 1st affidavit) when it was clear that the same was pending objection;

(ii) Suggestion that the respondents had not opposed to the registration of the marks in the name of the applicants (para 20 of Yong's 2nd affidavit) when in law the opposition period as set out under s. 28 of the Trade Marks Act 1976 had yet to materialise.

[84] These factors should also be taken into consideration when the court considers whether the subject mark should be expunged from the Register or not.

Conclusion

[85] In conclusion, the court finds that trade mark under Registration Number 98/13089 is an entry rightfully made and rightfully remaining on the register maintained under the Trade Marks Act 1976. None of the prayers sought should be granted for the following reasons:

(i) TAMIN was first used by the respondents and their predecessors in title in relation to the goods specified under Trade Mark 98/13089 and this use was before the use by the applicants. This being the case, it is use of the mark by the applicants and not the respondents that would give rise to confusion and deception. Surely a subsequent user cannot come along and frustrate the rights of a prior user.

(ii) Being the first in time, the respondents were *bona fide* proprietors of the mark in relation to the goods specified under Trade Mark 98/13089.

(iii) The 1st respondent could be legitimately recorded as the registered proprietor by virtue of the internal arrangement between her and the other respondents within the Tamin group of companies.

(iv) Registration of the respondents mark cannot be said to be contrary to law.

(v) There are various reasons for the court exercising discretion in favour of maintaining trade mark under Registration Number 98/13089.

[86] Having considered the above issues, the court rules that the prayers set out in the notice of originating motion (encl. 1) filed by the applicants be dismissed with cost.